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PATENT APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
SATOSHI KOIZUMI ET. AL.) Examiner: Manjunath Rao
Application No.: 09/068,528) Group Art Unit: 1652
Filed: May 13, 1998)
For: PROCESSES FOR PRODUCING)
SUGAR NUCLEOTIDES AND)
COMPLEX CARBOHYDRATES) May 17, 2000

PETITION FOR EXTENSION OF TIME
AND
RESPONSE TO RESTRICTION REQUIREMENT

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Sir:

Applicants petition the Commissioner of Patents and Trademarks to extend the time for responding to the Office Action dated December 23, 1999 in the above-identified application for three months from January 23, 2000 to May 23, 2000. Submitted herewith is a check in the amount of \$1360.00 to cover the fee for the extension under 35 C.F.R. § 1.17. Any deficiency in or overpayment of this fee should be charged or credited to Deposit Account 06-1205.

Applicants respond to the Official Action dated December 23, 1999 (Paper No. 13) in the above-identified application, as follows.

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REMARKS

In the outstanding Office Action, the Examiner required that Applicants elect for prosecution one of the inventions of:

Group I (Claims 1, 5, 8, 15-18 and 20), drawn to a process for producing a sugar nucleotide;

Group II (Claims 2-4, 6, 7 and 9-14), drawn to a process for producing a complex carbohydrate;

Group III (Claims 21-24), drawn to process for producing a sugar nucleotide using the enzymes glk, pgm, galU or ppa;

Group IV (Claim 25), drawn to process for producing a sugar nucleotide using diphosphoglucose dehydrogenase enzyme;

Group V (Claims 26-29), drawn to process for producing a sugar nucleotide using galK enzyme;

Group VI (Claims 30-32), drawn to process for producing a sugar nucleotide using galT enzyme;

Group VII (Claims 33-36), drawn to process for producing a sugar nucleotide using glK, pgm, galU or ppa enzyme;

Group VIII (Claims 37-39), drawn to process for producing a sugar nucleotide using glmU enzyme;

Group IX (Claims 40-45), drawn to process for producing a sugar nucleotide using pgm, ptkB enzyme;

Group X (Claims 46-49), drawn to process for producing a sugar nucleotide using glmU, ppa, glmM or glk enzyme;

Group XI (Claims 50-53), drawn to process for producing a sugar nucleotide using manB, manC, glk enzyme;

Group XII (Claims 54-57), drawn to process for producing a sugar nucleotide using manB, manC, glk, gmd, wcaG enzyme;

Group XIII (Claims 58-61), drawn to process for producing a sugar nucleotide using neuA, nanA, neuB, pyrG enzyme;

Group XIV (Claims 62-64), drawn to process for producing a sugar nucleotide using glycosyltransferase, galactosyltransferase, N-acetylglucosaminyltransferase, N-acetylgalactosaminyltransferase, glucuronosyltransferase, mannosyltransferase, sialyltransferase, fucosyltransferase;

Group XV (Claims 65-67), drawn to process for producing a sugar nucleotide using enzyme prepared from animal cell lines; or

Group XVI (Claims 68-71), drawn to process for producing N-acetylglucosamine-1-phosphate.

In response, Applicants hereby elect to prosecute the invention of Group I, namely claims 1, 5, 8, 15-18 and 20. However, Applicants wish to point out to the Examiner the Commissioner's Official Gazette Notice of March 4, 1996 "Guidance on Treatment of Product and Process Claims" which addresses the issue of processes "limited to making or using

a nonobvious product" and stated that claims to the nonelected process should be rejoined when a product claim is found allowable and the withdrawn process contains all the limitations of an allowed product claim. Accordingly, Applicants request that the subject matter of Group II, namely Claims 2-4, 6, 7 and 9-14, which include the features of claim 1, be rejoined in due course.


In addition, the Examiner has requested that Applicants select for search a single species of nucleotide precursor, sugar nucleotide and sugar. In response, Applicants make the following selection of species.

| Generic term in claim 1 | Species | Readable claims |
|-------------------------|----------------------------|-----------------|
| nucleotide precursor | orotic acid | 1 and 5 |
| sugar nucleotide | uridine diphosphogalactose | 1, 6 and 7 |
| sugar | galactose | 1 and 8 |

Entry hereof is earnestly solicited.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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